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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,771	02/05/2002	Charles Eldering	T742-10	7576

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME  
2003 SOUTH EASTON RD  
SUITE 208  
DOYLESTOWN ROAD, PA 18901

EXAMINER

HUYNH, SON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/068,771

Applicant(s)

ELDERING ET AL.

Examiner

Son P. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 194, 197-200, 202 and 213-233 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 194, 197-200, 202 and 213-233 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 194-212 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1-193, 195-196, 201, 203-212 have been cancelled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 194, 197-200, 202, 213-233 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US 6,463,585), in view of Unger (US 6,909,837), and further in view of Chang et al. (US 2002/0129362).

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Regarding claim 194, Hendricks discloses a method for delivering targeted advertisements to a subscriber with video that the subscriber selected to receive from a television delivery system (col. 3, line 48-col. 4, line 5), the method comprising:

selecting the video (selecting a program carried in program channel – col. 9, lines 5-20, col. 17, lines 15-35);

determining available advertisement opportunities in the selected video (e.g, determining “pods”, breaking time, etc. in the program – col. 5, lines 30-60, col. 27, lines 16-38);

selecting one or more targeted advertisements desired to be displayed to the subscriber, wherein the targeted advertisements correspond to the available advertisement opportunities (selecting targeted advertisements desired to be displayed to the subscriber, wherein the targeted advertisement correspond to “pod”, break timing, feeder channel availability, user demographic and user geographic (col. 26, line 14-col. 27, line 67);

delivering the selected video and the targeted advertisements to the subscriber (col. 26, line 14-col. 27, line 67);

presenting the selected video and the targeted advertisement to the subscriber on a viewing device (displaying selected program and displaying targeted advertisement during program break – col. 15, line 60-col. 16, line 12). Hendricks further discloses presenting alternative advertisement (col. 26, lines 14-30). However, Hendricks does not specifically disclose, presenting, upon detection of a fast-forward or skip operation of the targeted advertisement, an alternative advertisement, as a partial screen display

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in conjunction with the fast-forwarded or skipped advertisement, wherein the alternative advertisement and the fast –forwarded or skipped targeted advertisement are simultaneously presented to the subscriber and wherein the alternative advertisement is for a product or service directly related to the product or service of the targeted advertisement.

Unger discloses presenting, upon detection of a fast-forward or skip operation of the targeted advertisement, an alternative advertisement (upon detecting past forward operation of the commercial during commercial breaks, presenting a tagged frame as a still image or playing the series of tagged frames at normal speed as a condensed video clip – col. 2, line 45-col. 3, line 39; col. 5, lines 10-25, lines 33-62); wherein alternative advertisement is for a product or service directly related to the product or service of the targeted advertisement (tagged frames or series of tagged frames are frames of the commercial being fast forwarded such as a picture of the product being advertised, etc.– col. 3, line 64-col. 4, line 2). Unger further disclose if the fast forward command is received, the frames of the recorded video signal (commercial in commercial breaks being advertised) will be displayed at an accelerated rate (col. 5, lines 35-37; col. 6, lines 33) and if the tagged frame/ or frames of the commercial being fast-forwarded is detected, the tagged frame/frames also display as static image or normal speed as condensed video clip (col. 5, lines 50-62; col. 6, lines 35-53). Thus, the alternative advertisement (tagged frame or tagged frames) and the fast-forwarded targeted advertisement (advertisement with frames being displayed as accelerated rate) are simultaneously presented to the subscriber. Therefore, it would have been obvious to

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one of ordinary skill in the art at the time the invention was made to modify Hendricks to use the teaching as taught by Unger in order minimize the interruption to the programming caused by interspersed commercial messages, while also protecting the broadcaster's source of revenue by providing the advertiser with a means of reaching potential customers with, at least, an abbreviated advertising message (col. 2, lines 35-42). However, neither Hendricks nor Unger specifically disclose alternative advertisement is presented as a partial screen display in conjunction with the targeted advertisement.

Chang discloses alternative advertisement is presented as a partial screen display in conjunction with the targeted advertisement, and alternative commercials and main commercial are simultaneously presented to the user (alternative commercials 604, 606 is presented in a smaller windows with the main commercial being played, and they are simultaneously presented to the users - paragraphs 0057-0058, figure 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks and Unger to use the teaching as taught by Chang in order to improve convenience to users and thereby to provide a way to more efficiently tailor television commercials to viewers to heighten viewer interest in the commercials shown (paragraph 0007).

Regarding claim 197, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Chang further discloses alternative commercials

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604,606 superimposed in smaller windows with the main commercial (par. 0057, figure 6).

Regarding claim 198, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Unger further discloses the alternative advertisement is a compressed version of the target advertisement (tagged frame/frames as static image or condensed video clip of the commercial being fast-forwarded – col. 2, lines 45-60; col. 5, lines 50-62; col. 6, lines 35-54).

Regarding claim 199, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Hendricks further discloses selection of the target advertisement is based on a subscriber profile (see including, but is not limited to, col. 4, lines 35-42).

Regarding claim 200, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 199. Hendricks further discloses the subscriber profile defines trails associated with the subscriber, household demographics, traits associated with the selected video, or trails associated with previous selected videos (see including, but is not limited to, col. 4, lines 35-42).

Regarding claim 202, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Unger further discloses the alternative

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advertisement (tagged frame/frames) is derived from the targeted advertisement (tagged frame/frames are portion (abbreviated commercial message) of full length commercials –col. 2, lines 45-60; col. 5, lines 50-62; col. 6, lines 35-53).

Regarding claim 213, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Unger further discloses the alternative advertisement includes one or more video segments from the targeted advertisement (i.e. a frame or series of frames of the full length commercials – col. 2, lines 45-60; col. 5, lines 50-62; col. 6, lines 35-53; figure 4).

Regarding claims 214 and 216, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Chang further discloses the partial screen display is an overlay (i.e. alternative commercials 604, 606 superimposed main commercial – paragraph 0057, lines 22-24) or the partial screen display is a picture-in-picture (paragraph 0058).

Regarding claim 215, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Hendricks further discloses split screen video (col. 14, lines 20-25). Chang discloses displaying alternative commercials on partial screen (figure 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display alternative commercial in split screen in order to minimize interfering of data being displayed on the screen.



Regarding claim 217, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Neither reference discloses partial screen display is a bug. Official Notice is taken that using partial screen display as a bug is well known in the art. For example, displaying commercials, logo, weather information, etc. on partial screen as a bug. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks, Unger and Chang to use the well-known teaching in the art in order to minimize interfering of other data on the main screen.

Regarding claim 218, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Chang further discloses the partial screen display is a computer graphic (i.e. web page, see including, but is not limited to, paragraphs 0021, 0040).

Regarding claim 219, Hendricks in view of Unger and Chang teaches a method as discussed in the rejection of claim 194. Chang further discloses all commercials are provided according to user preferences/user profile (paragraphs 0042-0045). Therefore, the alternative commercial is targeted to the subscriber since it is customized based on user preferences/user profile).

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Regarding claim 220, Hendricks discloses a method for delivering targeted advertisements to a subscriber with video that the subscriber selected to receive from a television delivery system (col. 3, line 48-col. 4, line 5), the method comprising:

selecting the video (selecting a program carried in program channel – col. 9, lines 5-20, col. 17, lines 15-35);

determining available advertisement opportunities in the selected video (e.g, determining “pods”, breaking time, etc. in the program – col. 5, lines 30-60, col. 27, lines 16-38);

selecting one or more targeted advertisements desired to be displayed to the subscriber, wherein the targeted advertisements correspond to the available advertisement opportunities (selecting targeted advertisements desired to be displayed to the subscriber, wherein the targeted advertisement correspond to “pod”, break timing, feeder channel availability, user demographic and user geographic (col. 26, line 14-col. 27, line 67);

delivering the selected video and the targeted advertisements to the subscriber (col. 26, line 14-col. 27, line 67);

presenting the selected video and the targeted advertisement to the subscriber on a viewing device (displaying selected program and displaying targeted advertisement during program break – col. 15, line 60-col. 16, line 12). Hendricks further discloses presenting alternative advertisement (col. 26, lines 14-30). However, Hendricks does not specifically disclose, presenting, upon detection of a fast-forward or skip operation of the targeted advertisement, an alternative advertisement, as a partial screen display

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in conjunction with the fast-forwarded or skipped advertisement, wherein the alternative advertisement and the fast –forwarded or skipped targeted advertisement are simultaneously presented to the subscriber and wherein the alternative advertisement is a compressed version of the targeted advertisement.

Unger discloses presenting, upon detection of a fast-forward or skip operation of the targeted advertisement, an alternative advertisement (upon detecting past forward operation of the commercial during commercial breaks, presenting a tagged frame as a still image or playing the series of tagged frames at normal speed as a condensed video clip – col. 2, line 45-col. 3, line 39; col. 5, lines 10-25, lines 33-62); Unger further disclose if the fast forward command is received, the frames of the recorded video signal (commercial in commercial breaks being advertised) will be displayed at an accelerated rate (col. 5, lines 35-37; col. 6, lines 33) and if the tagged frame/ or frames of the commercial being fast-forwarded is detected, the tagged frame/frames also display as static image or normal speed as condensed video clip (col. 5, lines 50-62; col. 6, lines 35-53). Thus, the alternative advertisement (tagged frame or tagged frames) and the fast-forwarded targeted advertisement (advertisement with frames being displayed as accelerated rate) are simultaneously presented to the subscriber. Unger further discloses the alternative advertisement is a compressed version of the target advertisement (tagged frame/frames as static image or condensed video clip of the commercial being fast-forwarded – col. 2, lines 45-60; col. 5, lines 50-62; col. 6, lines 35-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks to use the teaching as taught by

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Unger in order minimize the interruption to the programming caused by interspersed commercial messages, while also protecting the broadcaster's source of revenue by providing the advertiser with a means of reaching potential customers with, at least, an abbreviated advertising message (col. 2, lines 35-42). However, neither Hendricks nor Unger specifically disclose alternative advertisement is presented as a partial screen display in conjunction with the targeted advertisement.

Chang discloses alternative advertisement is presented as a partial screen display in conjunction with the targeted advertisement, and alternative commercials and main commercial are simultaneously presented to the user (alternative commercials 604, 606 is presented in a smaller windows with the main commercial being played, and they are simultaneously presented to the users - paragraphs 0057-0058, figure 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks and Unger to use the teaching as taught by Chang in order to improve convenience to users and thereby to provide a way to more efficiently tailor television commercials to viewers to heighten viewer interest in the commercials shown (paragraph 0007).

Regarding claims 221-223, 225-231, 233, the additional limitations as claimed correspond to the additional limitations as claimed in claims 197, 199-200, 202, 213-218, 219 respectively, and are analyzed as discussed with respect to the rejection of claims 197, 199-200, 202, 213-218, 219.

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Regarding claim 224, Hendricks in view of Unger and Chang discloses a method as discussed in the rejection of claim 220. Unger further discloses the alternative advertisement (i.e. company logo or name of commercial being fast-forwarded) is not directly related to the targeted advertisement (the commercial being fast forwarded – see col. 5, lines 53-56)

Regarding claim 232, Hendricks in view of Unger and Chang discloses a method as discussed in the rejection of claim 220. Chang further discloses receiving different types of commercial such as beer commercial, on-line shopping commercials, automobile commercials (paragraph 0044), and once a commercial is playing; the user has an option to change it to an alternative commercial (paragraphs 0057-0058). It is obvious to one of ordinary skill in the art that the alternative advertisement is directed to a product or service (i.e. automobile) unrelated to the product or service of the targeted advertisement (i.e. beer) in order to provide a different advertisement to the user thereby increase chance for user to purchase the product.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Vince (US 2003/0228018) discloses seamless switching between multiple pre-encrypted video files.

Youden et al. (US 5,606,359) discloses video on demand system with multiple data sources configured to provide VCR like services.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P. Huynh whose telephone number is 571-272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 571-272-7294. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SPH  
February 6, 2006

 **HAITRAN  
PRIMARY EXAMINER**